



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,589	01/11/2002	Soeren H. Thomsen	29505/PF02187NA	4731

29978 7590 10/21/2003

MARSHALL, GERSTEIN & BORUN (MOTOROLA)
233 SOUTH WACKER DRIVE
SUITE 6300
CHICAGO, IL 60606-6402

EXAMINER

EWART, JAMES D

ART UNIT	PAPER NUMBER
----------	--------------

2683

DATE MAILED: 10/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/044,589

Applicant(s)

THOMSEN ET AL.

Examiner

James D Ewart

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Response to Arguments

1. Applicant's have amended the abstract as requested, therefore the objection to the abstract is withdrawn.
2. The applicants arguments regarding prior art rejections under 103(a), filed October 6, 2003, have been fully considered by the Examiner, but they are not deemed to be persuasive.
3. Regarding the declaration submitted by applicant that the invention was diligently being worked on earlier than the actual filing date, it is stated that evidence is in the form of a Motorola Invention Disclosure, Document No. PF 2187NA exhibit C. The office did not receive exhibit C, therefore the declaration is not persuasive.
4. Regarding the effective filing date of patent publications, under the Intellectual Property Amendments Act of November 4, 2002 change to 102(e) indicates that as long as the patent publication has a date of 11/29/00 or greater, the effective filing date of the patent publication (provisional data, continuity data) can be used in a 103(a) rejection. Similar to a US patent, the foreign priority date cannot be used as the effective filing date.
5. Regarding the motivation of combining Matsumoto et al with Appelman et al., Appelman et al relates to messaging application (e.g., e-mail, instant messaging, chat rooms etc.) interface. The message includes a time stamp, but Appelman et al does not refer to putting the messages in order based on the time stamp. Matsumoto et al teaches a chat system that puts the messages in

order based on the time stamp. It is justifiable to combine Appelman et al. with Matsumoto et al to provide a discussion through a chat system wherein the chat messages are time sequentially displayed. Alternatively, motivation is to provide a chat display that improves the ability to grasp the trend of the opinion of each speaker [0008]. The alternative motivation is from the same paragraph as the motivation used in the rejection.

6. Regarding the motivation of combining Appelman et al and Matsumoto et al with Golan. Golan relates to e-mail and associating the message with another message. It is justifiable to combine Appelman et al and Matsumoto et al with Golan so that the receiver can easily determine what the sender is referring to or as stated in paragraph 0031 "Fig. 2 shows an illustrative, non-limiting example of such a corrected e-mail message, with the original, incorrect e-mail message shown as an attachment at the bottom of the corrected message" ". In addition, examiner did not need to make the combination of Appelman et al and Matsumoto et al with Golan as the limitation required reference to only one of the following: a message identifier, a subscriber identifier and a hash value.

7. Regarding the motivation of combining Appelman et al and Matsumoto et al with Isaacs et al., Isaacs et al teaches communicating via instant messaging in which includes the use of the internet protocol. Appelman also teaches communicating via instant messaging, but does not mention protocols. It is justifiable to combine Appelman et al and Matsumoto et al with Isaacs et al to enable the devices to communicate wirelessly.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-4, 7-14, 17, 19-22, and 25-27 are rejected under 35 USC 103(a) as being unpatentable over Appelman et al. (U.S. Patent No. 6,539,421) and further in view of Matsumoto et al. (U.S. Patent Pub no. 2002/0023128).

Referring to claim 1, Appelman et al teaches a communication system providing real-time communication service to a plurality of subscribers, wherein the plurality of subscribers generates a plurality of real-time communication messages during a real-time communication session (Column 3, Lines 18 – 39), a method for providing a message creation reference associated with a real-time communication message comprising: generating a message creation reference associated with a real-time communication message (Column 9, Lines 49 – 50), the real-time communication message being generated by one of the plurality of subscribers (Figure 28); and transmitting the message creation reference and the real-time communication message (Figure 28). Although figures 16 to 31 show a time related message sequence and the time stamp provides the time when the message was sent, Appelman et al does not specifically teach that the real-time communication message is arranged relative to the plurality of real-time communication messages during the real-time communication session based on the message

Application/Control Number: 10/044,589

Art Unit: 2683

creation reference. Matsumoto et al teaches the real-time communication message is arranged relative to the plurality of real-time communication messages during the real-time communication session based on the message creation reference [0032, 0090]. Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the art of Appelman et al with the art of Matsumoto et al wherein the real-time communication message is arranged relative to the plurality of real-time communication messages during the real-time communication session based on the message creation reference to provide a discussion through a chat system wherein the chat messages are time sequentially displayed [0008].

Referring to claim 9, Appelman et al teaches a communication system providing real-time communication service to a plurality of subscribers, wherein the plurality of subscribers generates a plurality of real-time communication messages (Column 3, Lines 18 – 39), and wherein an apparatus is adapted to provide a message creation reference associated with a real-time communication message (Column 9, Lines 49 – 50), the apparatus comprising: a memory (Figure 2); a controller coupled to the memory (Figure 2), the controller being operable to generate a message creation reference associated with a real-time communication message generated by one of the plurality of subscribers (Figure 28), and the controller being operable to transmit the message creation reference and the real-time communication message (Figure 28). Although figures 16 to 31 show a time related message sequence and the time stamp provides the time when the message was sent, Appelman et al does not specifically teach that the real-time communication message is arranged relative to the plurality of real-time communication

Application/Control Number: 10/044,589

Art Unit: 2683

messages during the real-time communication session based on the message creation reference. Matsumoto et al teaches the real-time communication message is arranged relative to the plurality of real-time communication messages during the real-time communication session based on the message creation reference [0032, 0090]. Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the art of Appelman et al with the art of Matsumoto et al wherein the real-time communication message is arranged relative to the plurality of real-time communication messages during the real-time communication session based on the message creation reference to provide a discussion through a chat system wherein the chat messages are time sequentially displayed [0008].

Referring to claim 19, Appelman et al teaches a communication system for providing real-time communication service to a plurality of subscribers, wherein the plurality of subscribers generates a plurality of real-time communication messages (Column 3, Lines 18 – 39), and wherein a controller operates in accordance with a computer program (Column 3, Lines 18 – 31) embodied on a computer-readable medium for providing a message creation reference associated with a real-time communication message (Column 9, Lines 49 – 50), the computer program comprising: a first routine that directs the controller to generate a message creation reference associated with a real-time communication message (Column 9, Lines 49 – 50), the real-time communication message being generated by one of the plurality of subscribers; and a second routine that directs the controller to transmit the message creation reference and the real-time communication message (Figure 28). Although figures 16 to 31 show a time related message sequence and the time stamp provides the time when the message was sent, Appelman

Application/Control Number: 10/044,589

Art Unit: 2683

et al does not specifically teach that the real-time communication message is arranged relative to the plurality of real-time communication messages during the real-time communication session based on the message creation reference. Matsumoto et al teaches the real-time communication message is arranged relative to the plurality of real-time communication messages during the real-time communication session based on the message creation reference [0032, 0090].

Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the art of Appelman et al with the art of Matsumoto et al wherein the real-time communication message is arranged relative to the plurality of real-time communication messages during the real-time communication session based on the message creation reference to provide a discussion through a chat system wherein the chat messages are time sequentially displayed [0008].

Referring to claims 2, 13 and 20, Appelman et al further teaches wherein the step of generating a message creation reference associated with a real-time communication message comprises generating a message creation reference associated with one of an instant messaging message and a group chat message (Column 3, Lines 18-31).

Referring to claims 3, 10 and 21, Appelman et al further teaches wherein the step of generating a message creation reference associated with a real-time communication message comprises generating a message creation reference associated with a real-time communication message in response to a subscriber input via one of an alphanumeric keypad, a numeric keypad, a touch-sensitive display and a microphone (Column 4, Lines 32-43).

Application/Control Number: 10/044,589

Art Unit: 2683

Referring to claims 4, 14 and 22, Appelman et al further teaches wherein the step of generating a message creation reference associated with a real-time communication message comprises generating a time stamp associated with a real-time communication message (Column 9, Lines 30-38).

Referring to claims 7, 11, and 25, Appelman et al teaches the limitations of claims 7, 11 and 25 including wherein the step of transmitting the message creation reference and the real-time communication message comprises transmitting the message creation reference and the real-time communication message in response to a subscriber input via one of an alphanumeric keypad, a numeric keypad, a touch-sensitive display and a microphone (Column 4, Lines 32-43). Although figures 16 to 31 show a time related message sequence and the time stamp provides the time when the message was sent, Appelman et al does not specifically teach wherein the real-time communication message is arranged relative to the plurality of real-time communication messages during a real-time communication session based on the message creation reference. Matsumoto et al teaches the real-time communication message is arranged relative to the plurality of real-time communication messages during the real-time communication session based on the message creation reference [0032, 0090]. Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the art of Appelman et al with the art of Matsumoto et al wherein the real-time communication message is arranged relative to the plurality of real-time communication messages during the real-time communication session based on the message creation reference to

Application/Control Number: 10/044,589

Art Unit: 2683

provide a discussion through a chat system wherein the chat messages are time sequentially displayed [0008].

Referring to claims 8, 12 and 26, Appelman et al teaches the limitations of claims 8, 12 and 26 including wherein the step of transmitting the message creation reference and the real-time communication message comprises transmitting the message creation reference and the real-time communication message during one of an instant messaging session and a group chat session (Figure 28 and Column 3, Lines 18-31). Although figures 16 to 31 show a time related message sequence and the time stamp provides the time when the message was sent, Appelman et al does not specifically teach wherein the real-time communication message is arranged relative to the plurality of real-time communication messages. Matsumoto et al teaches the real-time communication message is arranged relative to the plurality of real-time communication [0032, 0090]. Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the art of Appelman et al with the art of Matsumoto et al wherein the real-time communication message is arranged relative to the plurality of real-time communication messages to provide a discussion through a chat system wherein the chat messages are time sequentially displayed [0008].

Referring to claim 17, Appelman et al further teaches wherein the apparatus comprises one of a cellular telephone, a pager, an electronic planner, and a communication network (Column 13, Lines 20-22).

Application/Control Number: 10/044,589

Art Unit: 2683

Referring to claim 27, Appelman et al further teaches wherein the medium comprises one of paper, a programmable gate array, application specific integrated circuit, erasable programmable read only memory, read only memory, random access memory, magnetic media, and optical media (Column 13, Lines 49-56) .

9. Claims 5, 6, 15, 16, 23, and 24 are rejected under 35 USC 103(a) as being unpatentable over Appelman et al and Matsumoto et al and further in view of Golan (U.S. Patent Pub no. 2002/0194278).

Referring to claims 5, 6, 15, 16, 23 and 24, Appelman et al further teaches wherein the step of generating a message creation reference associated with a real-time communication message comprises generating one of a message identifier (Column 9, Lines 49-50, time stamp) a subscriber identifier (Figure 3; 134 and 135 and Figure 20; 690, 698), but neither Appleman et al or Matsumoto et al teach a hash value associated with a real-time communication message based on an incoming message parameter, and wherein the incoming message parameter is associated with an incoming message from one of the plurality of subscribers. When replying to e-mail, it is well know to include the message being replied to so that the receiver can easily determine what the sender is referring to. Golan teaches sending a message that includes a message parameter associated with a received message in order to associate the message with the message received. (Figure 2, attachment). Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teachings of Appleman et al and Matsumoto et al with the teachings of Golan of sending a message which includes a message

Application/Control Number: 10/044,589

Art Unit: 2683

parameter associated with a received message in order to associate the message with the message received so that the receiver can easily determine what the sender is referring to (0031).

10. Claim 18 is rejected under 35 USC 103(a) as being unpatentable over Appelman et al and Matsumoto et al and further in view of Isaacs et al. (U.S. Patent Pub no. 2002/0026483).

Referring to claim 18, Appelman et al and Matsumoto et al teach the limitations of claim 18, but do not teach wherein the apparatus comprises one of an Internet Protocol (IP) network and a General Packet Radio Services (GPRS) network. Isaacs et al teaches wherein the apparatus comprises one of an Internet Protocol (IP) network and a General Packet Radio Services (GPRS) network [0027]. Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teachings of Appelman et al and Matsumoto et al with the teachings of Isaacs et al wherein the apparatus comprises one of an Internet Protocol (IP) network and a General Packet Radio Services (GPRS) network to allow devices to communicate wirelessly [0027]

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Fennel, Jr. et al. U.S. Patent No. 5,695,400 discloses method of managing multi-player game playing over a network.

Application/Control Number: 10/044,589

Art Unit: 2683

Leahy et al. U.S. Patent No. 6,219,045 discloses scalable virtual world chat client-server system.

Ung et al. U.S. Patent Pub. No. 2001/0031641 discloses wireless chat automatic status tracking.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James D Ewart whose telephone number is (703) 305-4826. The examiner can normally be reached on M-F 7am - 4pm.

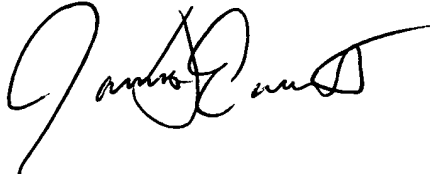
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (703)308-5318. The fax phone numbers for the organization

Application/Control Number: 10/044,589

Art Unit: 2683

where this application or proceeding is assigned are (703)305-9508 for regular communications and (703)305-9508 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.



Ewart
October 8, 2003



WILLIAM TROST
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600